

## **REMARKS**

### **I. Introduction**

Claims 1-24 and 26-27 are now in the application. Claims 2, 10, 17, and 24 have been amended. Claim 25 has been cancelled. Reconsideration of the rejection of claims 1-24 and 26-27 and allowance of the same are respectfully requested.

The instant response is the result of a great deal of frustration by Applicants. This is the second consecutive Office Action in which the Examiner has rejected claims over patents which are not prior art to the pending application (Pensak in the previous Office Action, and Jevens in the present Office Action.) Also, the obviousness rejections are not well grounded in fact — in most cases either based on (1) citations to patents which do not disclose the proposition for which the Examiner states, or (2) the suggested modifications are simply inconsistent with the cited art. Given the length of the Office Actions (which are easily 3-4 times the size of typical a Office Action to address 20-30 claims), the response has consumed considerably more resources by Applicants than should be the case.

By way of non-limiting example, the Examiner has cited Yaegashi in all rejections. In particular, the Examiner cites to column 12, lines 20-63, for various reasons. The cited portion of Yaegashi is as follows.

If the decryption key is not stored locally, or if a key expiration security mechanism has been set and activated, the system moves to Step 10. A key expiration security mechanism, if set, would invalidate any stored keys if too much time has passed since the last use of the keys or if an invalid attempt to access stored keys is detected. This mechanism would preferably be implemented as part of the security system of the secure database stored with the information access systems 130, 140, 150.

In Step 10, the information access system 130 requests the decryption key by transmitting its remote location identification number (a public key) and the disc identification information 200 to the central access control system 100 via the bi-lateral communications link 132. Next, in Step S11, the central access control system 100, will attempt to verify the request by performing a database lookup to determine if valid disc identification information 200 has been presented in a correct, predefined format by a valid requester using a valid remote location identification number. If the request cannot be verified, the system moves to Step S18, where the request is denied and an attempted security breach alert is triggered and logged. If, on the other hand, the request is verified, the central access control system 100 will next attempt to determine whether the requester is authorized in Step S12. Authorization is determined based upon a database lookup of the remote location identification number within the ARL as described above. If the requester is not listed on the ARL, the system moves to Step S18, where the request is denied and an attempted security breach alert is triggered and logged. If, on the other hand, the requester is authorized, the system moves to Step S13.

In Step S13, the requested decryption key is itself encrypted using the remote location identification number of the requester as a public key. In Step S14, the encrypted decryption key is transmitted to the requesting information access system 130 via the bi-lateral communication link 132 by the central access control system 100. Once the encrypted decryption key is received by the information access system 130, it is decrypted in Step S15. In Step S16, the decryption key for the distribution CD 120 is stored for future use by the logged-in user. Finally, in Step S17, the distribution CD 120 is decrypted.

Based on the above disclosure, virtually every rejection put forth by the Examiner includes the following paragraph:

However, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify (or to set/configure) the “elapsed time since the last use of the key” with the value of “zero” to accommodate “destroying the key immediately” because this enhances the security assuming the security concern outweighs the cost of additional processing time required when the key is needed again.

The Examiner's rationale is in direct conflict with the Yaegashi disclosure. Yaegashi states at column 12, lines 22-26, that the key destruction occurs after "too much time has passed." Such disclosure teaches a preference for maintaining a key locally for at least some period of time. Such disclosure does not suggest, and indeed teaches directly away from, setting an elapsed time at "zero."

Indeed, the disclosed Yaegashi Step S9 (Fig. 3) would become meaningless under the Examiner's rationale. Per that step, a determination is made whether the key is present locally. If the key expiration system is set at zero for immediate key destruction, then the key would never be present locally for step S9 to determine its presence. In essence, the Examiner's theory simply reads the presence of Yaegashi step S9 right out of the claim.

Accordingly, Yaegashi does not provide any support or motivation to set anything to "zero." Nor does any of the other prior art which the Examiner has applied. Accordingly, to the extent that the Examiner relies on the above-quoted rationale, this rejection is simply at odds with the record.

## **II. Substantive Rejections**

Claim 1 has been rejected under 35 U.S.C. § 103 as obvious over Yaegashi. The Examiner's rejection is respectfully traversed. Claim 1 recites "destroying the unprotected copy of the decryption key at the user location in response to said decrypting." To meet this limitation, the Examiner relies upon the supposed ability to set a Yaegashi parameter to "zero." As stated above, this rationale is inconsistent with the teachings of Yaegashi. On this basis alone, withdrawal of the rejection of claim 1 is proper and requested.

Claims 2 and 4, which depend from claim 1, have been rejected under 35 U.S.C. § 103 as obvious over Yaegashi in view of Deng, and in view of Okatamo. The Examiner's rejection is traversed.

Applicants initially note that the rationale of the rejection does not match the cited art because the Examiner did not use or rely upon the Deng reference in the analysis of claims 2 or 4. It is therefore unclear as to what elements of these claims the Examiner believes are missing from Yaegashi and/or Okatamo for which reliance on Deng is necessary. Absent the presence of such rationale, the Examiner has not provided Applicants with any specific points with which to rebut.

In any event, claims 2 and 4 include all the limitations of claim 1. As discussed above, the Examiner's rationale to reject claim 1 under the "zero" parameter theory is inconsistent with the disclosure of Yaegashi. The Examiner has not identified any teachings or suggestions in Deng or Okatamo which fill that void. Withdrawal of the rejection of claims 2 and 4 is therefore requested.

Claim 3, which depends from claim 1, has been rejected under 35 U.S.C. § 103 as obvious over Yaegashi. The Examiner's rejection is respectfully traversed. Just as independent claim 1 is patentably distinct over Yaegashi, so too is dependent claim 3. Withdrawal of the rejection and allowance of claim 3 is respectfully requested.

Claim 5 has been rejected under 35 U.S.C. § 102(e) as anticipated by Yaegashi. The Examiner's rejection is respectfully traversed. In order for a reference to anticipate a claimed invention, the reference must disclose each and every limitation found in the claim. If so much as a single limitation is not disclosed, then the rejection for anticipation may not be properly maintained.

Claim 5 recites the presence of “at least one time limitation associated with the decryption key.” Per the other language of claim 5, this at least one time limitation is sent to the user location. To meet this limitation, the Examiner has cited specifically to Yaegashi at column 12, lines 23-53, although later rejections to related language refer to column 12 beginning at line 20.

The Yaegashi disclosure at column 12, lines 20-28, refers to a “key expiration security system” that will “invalidate any stored keys if too much time has passed since the last use of the keys.” Nothing in this Yaegashi disclosure teaches or suggests that anything relating to time limits is sent to the user location from another location. To the contrary, column 12, lines 51-61, discloses only that the decryption key is being sent, but makes no mention of any other data being sent, let alone time limits associated with the decryption key. There is thus no disclosure in column 12 of Yaegashi, nor any other portion of Yaegashi, which teaches this language of claim 5.

Accordingly, claim 5 recites at least one feature which is not disclosed in the applied art. Withdrawal of the rejection of claim 5 and allowance of the same is therefore requested.

Claim 6, which depends from claim 1, has been rejected under 35 U.S.C. § 103 as obvious over Yaegashi in view of Jevans. Applicants traverse the rejection because Jevans is not prior art to the present application. Specifically the present application was filed on December 15, 2000, and Jevans was not filed until February 26, 2001. Jevans therefore does not qualify as prior art under any section of 35 U.S.C. § 102, and therefore cannot be included in an

obviousness rejection under 35 U.S.C. § 103 as a matter of law.<sup>1</sup> Withdrawal of the rejection of claim 6 and allowance of the same is therefore requested.

Claim 7, which depends from claim 5, has been rejected under 35 U.S.C. § 102(e) as anticipated by Yaegashi. For at least the reasons advanced with respect to claim 5, claim 7 is likewise patentably distinct over the applied art. Withdrawal of this rejection and allowance of the same is therefore respectfully requested.

Claim 8, which depends from claim 5, has been rejected under 35 U.S.C. § 103 as obvious over Yaegashi in view of Davis. The Examiner's rejection is traversed. The Examiner has not provided any rationale for the rejection other than "claim 8 does not further teach over claim 12." Claim 8 depends from claim 5, whereas claim 12 is a distinct independent claim. Claim 8 recites limitations not found in claim 12, such as "wherein the second information is insufficient in and of itself to decrypt the voucher." The relationship between claims 8 and 12 is therefore unclear, as is the Examiner's basis for this rejection. In any event, because the Examiner applies the same "zero" rationale to all of claims 5, 8, and 12, the rejection cannot be maintained regardless of the perceived relationship between claims 8 and 12. Withdrawal of the rejection of claim 8 and allowance of the same is therefore requested.

Claim 9, which depends from claim 5, has been rejected under 35 U.S.C. § 103 as anticipated by Yaegashi. For at least the reasons advanced with respect to claim 5, withdrawal of this rejection and allowance of the same is therefore respectfully requested. In addition, Claim 9 adds the additional step of "destroying the decryption key at the remote server after a predetermined period of time" for which the Examiner has applied the rationale of setting a Yaegashi parameter to "zero." As discussed above, such rationale is inconsistent with the

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<sup>1</sup> This is the second straight Office Action in which the Examiner has rejected pending claims using patents which do not qualify as prior art.

Yaegashi reference. For this additional independent reason, withdrawal of the rejection of claim 9 and allowance of the same is respectfully requested. Such language of claim 9 is neither properly taught nor suggested by Yaegashi. Accordingly, claim 9 recites a combination of features which is patentably distinct over the cited art. Withdrawal of the rejection for claim 9 and allowance of the same is therefore requested.

Claim 10, which depends from claim 5, has been rejected under 35 U.S.C. § 103 as obvious by Yaegashi in view of Chen. Applicants note that claim 10 contains a typographical error, in that it incorrectly depends from claim 5 instead of claim 1. This typographical error has been corrected by the present amendment.

To the extent that the rejection survives the above-noted amendment, Applicants traverse the rejection. The rejection against claim 1 utilizes the same “zero” rationale as discussed above, and the rejection cannot be maintained on that basis alone. In addition, the Examiner’s citation to column 11, lines 21-23, of Chen (*i.e.*, Chen claim 7) is misplaced. Claim 10, by virtue of its dependency on claim 1, recites “obtaining” the recited key, and “logging the obtaining in a log.” In contrast, the Examiner’s citation to Chen discloses “having the client computer monitor and log frame time and data rate of the video display and transmit the log to the server computer.” It is not clear how “frame time” or “display time” is something which is “obtained” and that it should be logged in a log. Further, the fact that video information (frame time and display rate) is being logged in one computer environment does not translate into a teaching or motivation to log and transmit obtaining of keys. Claim 10 is patentably distinct over Chen for this additional reason. Withdrawal of the rejection of claim 10 and allowance of the same is therefore requested.

Claim 11, which depends from claims 1 through claim 10, has also been rejected under 35 U.S.C. § 103 as obvious by Yaegashi in view of Chen. The Examiner's rejection is traversed for at least the reasons discussed with respect to claim 10. In addition, claim 11 recites logging a time of the obtaining. The cited portion of Chen provides no such teaching. Its recitation of a "frame time" is a parameter of the display device, not a specific time at which any information was obtained, let alone when a key was obtained. For this additional reason, claim 11 is patentably distinct over the applied art. Withdrawal of the rejection of claim 11 and allowance of the same is therefore requested.

Claim 12 has been rejected under 35 U.S.C. §103 as obvious over Yaegashi in view of Davis. The Examiner's rejection is traversed. The Examiner's rejection is based on the same "zero" rationale for Yaegashi as discussed at length above. The rationale is unfounded and the rejection cannot be maintained on this basis. Withdrawal of the rejection and allowance of the same is therefore requested.

Claim 13, which depends from claim 12, has been rejected under 35 U.S.C. § 103 as obvious over Yaegashi in view of Davis and Deng. The Examiner's rejection is traversed. As discussed above, the Examiner's rationale to reject claim 12 under the "zero" time theory is inconsistent with the disclosure of Yaegashi. The Examiner has not identified any teachings or suggestions in Deng or Davis which fills that void. Withdrawal of the rejection of claims 12 and 13 is therefore requested.

Claim 14, which depends from claim 12, has been rejected under 35 U.S.C. §103 as obvious over Yaegashi in view of Davis. The Examiner's rejection is traversed. The combination of Yaegashi and Davis does not render obvious claim 12, and thus does not render obvious claim 14 by virtue of its dependency from claim 12. In addition, claim 14 recites the



presence of access policies and the use thereof. The Examiner has cited to Yaegashi, column 12, lines 28-50, for such teachings, but has not specifically identified what data or elements correspond to the access policies, or how these unidentified data or elements are purportedly used in the manner recited in claim 14. Applicants have reviewed the cited portion of Yaegashi and can find no such corresponding disclosure. Accordingly, claim 14 is patentably distinct over the applied art. Withdrawal of the rejection and allowance of the same is therefore requested.

Claims 15 and 16 have been rejected under 35 U.S.C. § 103 as obvious over Yaegashi in view of Deng, and in view of Okatamo. The rationale for the Examiner's rejection is stated to be the same as for the rejection of claims 1 and 2. The Examiner's rejection is thus traversed for at least the reasons discussed with respect to claims 1 and 2, including that the Examiner does not explain the relevance of the Deng reference and that Yaegashi is inconsistent with a "zero" time parameter. Withdrawal of the rejection of claims 15 and 16 and allowance of the same are therefore requested.

Claim 17 has been rejected under 35 U.S.C. § 103 as obvious over Yaegashi in view of Okatamo. The rejection is again based on the "zero" time rationale applied throughout the Office Action, and which is inconsistent with the teachings of Yaegashi. Withdrawal of the rejection of claim 17 is therefore requested.

In addition, claim 17 recites breaking a connection between the user location and the remote server, and that certain actions are taken during the period of the broken connection. To meet this limitation, the Examiner states that Yaegashi discloses a modem which inherently opens and closes connections. This observation, however, does not address the claim language that requires that certain actions are taken during the period of the broken connection. In other words, the fact that the Examiner believes that Yaegashi teaches (1) performing certain claimed

actions (a point which Applicants disagree with), and (2) opening and closing connections, fails to teach or suggest performing the claimed actions during a period of a broken connection. It is as equally plausible that the Yaegashi actions occur in whole or in part while the connection is open. An obviousness rejection cannot be supported on this basis.

Accordingly, claim 17 is patentably distinct over the cited art. Withdrawal of the rejection and allowance of the same are therefore requested.

Claim 18, which depends from claim 17, has also been rejected under 35 U.S.C. § 103 as obvious over Yaegashi in view of Okatamo. For at least the reasons advanced in favor of claim 17, claim 18 is likewise patentably distinct over the applied art. Withdrawal of the rejection of claim 18 and allowance of the same are therefore requested.

Claim 19, which depends from claim 17 through claim 18, has also been rejected under 35 U.S.C. § 103 as obvious over Yaegashi in view of Okatamo. For at least the reasons advanced in favor of claim 17, claim 19 is likewise patentably distinct over the applied art. In addition, per claim 19, a connection is broken, actions are taken, and connection is restored, and the key lease is revoked. The Examiner attempts to meet this limitation with the Yaegahsi key expiration mechanism. However, as discussed with respect to claim 17, Yaegahsi is silent as to the relationship between these events and the presence, absence, opening or closing of the connection. There is nothing in the references which teaches or suggests that the Yaegashi key expiration mechanism activates after an otherwise unidentified broken connection supposedly is restored. Claim 19 is therefore patentably distinct over the applied art. Withdrawal of the rejection of claim 19 and allowance of the same are therefore requested.

Claim 20, which depends from claim 17 through claim 18, has been rejected under 35 U.S.C. §103 as obvious over Yaegahsi in view of Okamoto and Chen. The Examiner's

rejection is traversed. Claim 20 is patentably distinct over the combination of Yaegahsi and Okamoto for the reasons discussed with respect to claim 17. In addition, claim 20 recites “obtaining” the recited key, and “logging the obtaining in a log.” Chen discloses logging frame time and data rate of the video display and transmitting the log to the server computer.” It is not clear how “frame time” or “display time” is something which is “obtained” that it should be logged in a log. Further, the fact that video information (frame time and display rate) is being logged in one computer environment does not translate into a teaching or motivation to log and transmit obtaining of keys. Claim 20 is patentably distinct over Chen for this additional reason. Withdrawal of the rejection of claim 20 and allowance of the same are therefore requested.

Claim 21, which depends from claim 17 through claims 18 and 20, has been rejected under 35 U.S.C. §103 as obvious over Yaegahsi in view of Okamoto and Chen. The Examiner’s rejection is traversed for at least the reasons discussed with respect to claims 17, 18 and 20. Withdrawal of the rejection of claim 20 and allowance of the same are therefore requested.

Claim 22 has been rejected under 35 U.S.C. § 103 as obvious over Yaegashi in view of Deng, and in view of Okatamo. The rationale for the Examiner’s rejection is stated to be the same as for the rejection of claims 1-3. The Examiner’s rejection is thus traversed for at least the reasons discussed with respect to claims 1-3, including that the Examiner has failed to explain the relevance of the Deng reference and that Yaegashi is inconsistent with a “zero” time parameter. Withdrawal of the rejection of claim 22 and allowance of the same are therefore requested.

Claim 23 has been rejected under 35 U.S.C. § 103 as obvious over Yaegashi in view of Deng and Jevans. As discussed above, Jevens is not prior art to the present application and

cannot support an obviousness rejection. Withdrawal of the rejection and allowance of claim 23 are therefore requested.

Claim 24 has been rejected under 35 U.S.C. § 103 as obvious over Yaegashi. Claim 25 has been rejected under 35 U.S.C. § 103 as obvious over Yaegashi in view of Deng. Claim 24 has been amended to include the limitations of claim 25; and claim 25 has accordingly been cancelled. By this amendment, the original rejection against claim 24 has been rendered moot. The original rejection against claim 25 is now applied to claim 24 as amended. That rejection is respectfully traversed.

Claim 24 recites “destroying the decryption key at the remote server in response to the elapse of a predetermined period of time.” As pointed out by the Examiner, Yaegashi has a key expiration mechanism, but that key expiration mechanism is not at the remote server as claimed.<sup>2</sup> In addition, claim 24 as amended recites that the act of destruction renders the segment permanently inaccessible. The key expiration mechanism of Yaegashi teaches directly away from this claim language because Yaegashi retrieves a new key when the key expiration mechanism destroys the local copy of the key. Thus, the Yaegashi key expiration mechanism does not leave the segment permanently inaccessible as recited in claim 24.

What is lacking from Yaegashi is not provided by Deng. The cited portions of Deng merely state that the unencrypted copy of the document is removed from the memory where it is stored. Nothing in this disclosure indicates that new keys cannot be obtained from the server to decrypt the document at a later date. This fails to teach or suggest a permanent inaccessibility as recited in claim 24.

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<sup>2</sup> The Examiner has repeatedly relied upon the Yaegashi key expiration mechanism to meet claim limitations of key destruction at the user location (see, *e.g.*, rejection of claim 1, paragraph 10 of the Office Action). The Examiner is not at liberty to take that same Yaegashi disclosure and assert that the key destruction is occurring somewhere else.

Accordingly, claim 24 recites a combination of features which is neither taught nor suggested by the applied art. Withdrawal of the rejection of claim 24 and allowance of the same are therefore requested.

Claim 26 has been rejected under 35 U.S.C. § 103 as obvious over Yaegashi in view of Deng. The Examiner's rejection is respectfully traversed. The rejection is based in part on the "zero" time rationale discussed extensively herein. A rejection cannot be maintained on this basis. Withdrawal of the rejection and allowance of claim 26 are therefore requested.

Claim 27, which depends from claim 26, has been rejected under 35 U.S.C. § 103 as obvious over Yaegashi in view of Deng and Okamoto. The Examiner's rejection is traversed. Claim 27 is patentably distinct over Yaegashi in view of Deng for the reasons discussed with respect to claim 26. The tertiary citation to Okamoto does not address this deficiency. Claim 27 is therefore patentably distinct over the applied art. Withdrawal of the rejection and allowance of the same are therefore requested.

### **III. Formal Rejections**

Claims 1 and 26 have been rejected under the obviousness-type double patenting over U.S. Patent 6,289,450. The Examiner's rejection is traversed because it fails to set forth a *prima facie* case of obviousness. Obviousness cannot be established under the conclusory rationale that "encryption techniques for computer/security techniques are well known." The Examiner is requested to identify with specificity exactly what prior art references are being relied upon to modify or suggest the teachings of U.S. Patent 6,289,450 to meet the limitations of claims 1 and 26. Absent such express reasoning, the rejection may not be maintained.

Claim 17 has been rejected under 35 U.S.C. § 112, paragraph 2, for informalities. Claim 17 has been amended to address these informalities. Claim 17 is now clear and definite.

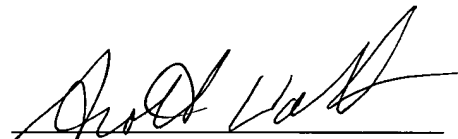
In view of the foregoing, the application is now believed to be in proper form for allowance, and a notice to that effect is earnestly solicited.

Please note that any amendments to the claims which have been made in this amendment, that have not been specifically noted to overcome a rejection based upon the prior art should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto. By way of non-limiting example, claims 2 and 10 have been amended to correct typographical errors, and no estoppel should attach thereto.

If a telephone conference would be of value, the Examiner is requested to call the undersigned attorney at the number listed below.

The Commissioner is hereby authorized to charge/credit any fee deficiencies or overpayments to Deposit Account No. 19-4293 (Order No. 11953.0003).

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Scott D. Watkins', is written over a horizontal line.

Scott D. Watkins  
Reg. No. 36,715

April 1, 2005  
Steptoe & Johnson LLP  
1330 Connecticut Ave., N.W.  
Washington, DC 20036  
(202) 429-3000